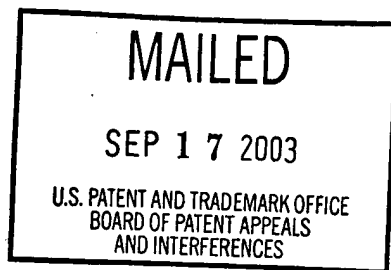


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte RICHARD J. ERICSON

Appeal No. 2003-0404
Application No. 09/162,821

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing¹ of our decision mailed June 23, 2003, wherein we affirmed the examiner's rejection of claims 2, 5, 6, 16, 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Gale in view of Habano; affirmed the examiner's rejection of claims 3, 17 and 18 under 35 U.S.C. § 103 as being unpatentable over Gale in view of Habano and Murtaugh; affirmed the examiner's

¹ Filed August 25, 2003.

rejection of claims 13, 14, 27 and 28 under 35 U.S.C. § 103 as being unpatentable over Gale in view of Habano and Aulanko; and reversed the examiner's rejection of claims 2 to 4 and 16 to 19 under 35 U.S.C. § 103 as being unpatentable over Murtaugh in view of Gale and Habano.

We have carefully considered the argument set forth by the appellant in the request for rehearing that there is no motivation in the applied prior art for an artisan to have modified Gale by the teachings of Habano to arrive at the subject matter of claim 16, however, that argument does not persuade us that our decision was in error in any respect.

On pages 7-8 of our decision, we stated:

Based on our analysis and review of Gale and claim 16, it is our opinion that the only difference is the limitation that the at least one flat rope include a suspension rope coupled to the elevator car as well as a drive rope engaging the drive motor for moving the elevator car.² In that regard, we note that Gale's cables 3 (i.e., suspension ropes) are not disclosed as being flat and from Figures 1-2 would appear to be round.

With regard to this difference, the examiner determined (answer, p. 6) that it would have been obvious to one of ordinary skill in the art to modify Gale's cables 3 (i.e., suspension ropes) to be a flat rope as suggested and taught by Habano. We agree.

² After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

The appellant argues through both briefs that there is no motivation in the teachings of Habano for a person of ordinary skill in the art to have modified Gale to arrive at the claimed subject matter. In our view, there is sufficient motivation in the teachings of Habano for a person of ordinary skill in the art at the time the invention was made to have modified Gale to arrive at the claimed subject matter. While it is true that Habano mostly discusses the use of a ribbon-form rope as a balance rope in elevators, Habano does specifically teach that the ribbon-form rope can be used as a hoisting rope in elevators. This specific teaching of Habano cannot be ignored. In our view, Habano's teachings that a ribbon-form rope can be used as a hoisting rope in elevators and that the ribbon-form rope eliminates the back-twisting tendency of conventional twisted ropes provides ample motivation for a person of ordinary skill in the art at the time the invention was made to have replaced Gale's cables 3 with a ribbon-form rope as taught by Habano.

The appellant argues that back-twisting would not have been a concern for the round cables 3 of Gale and therefore elimination of back-twisting would not have provided the necessary motivation to an artisan to have replaced Gale's cables 3 with a ribbon-form rope as taught by Habano. We find this argument unpersuasive as to the patentability of claim 16 for the following reasons. First, attorney argument in a request for rehearing cannot take the place of evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Second, our determination of the obviousness of the subject matter of claim 16 was not based solely on the elimination of back-twisting of Gale's cables 3 by the replacement of Gale's cables 3 with a ribbon-form rope. In that regard, it is our view that Habano's specific teaching that the ribbon-form rope can be used as a hoisting rope in elevators provides ample motivation for a person of ordinary skill in the art

at the time the invention was made to have replaced Gale's cables 3 with a ribbon-form rope as taught by Habano.

The appellant also argues that (1) Habano's teaching that the ribbon-form rope can be used as a hoisting rope in elevators should not be interpreted to refer to an elevator suspension rope and (2) even assuming, *arguendo* that Habano teaches that a ribbon-form rope can be used as a hoisting rope in elevators (i.e., an elevator suspension rope) that such a teaching would not have rendered the subject matter of claim 16 obvious under 35 U.S.C. § 103. We find this argument also unconvincing for the following reasons. First, it remains our determination that while Habano mostly discusses the use of a ribbon-form rope as a balance rope in elevators, Habano specifically teaches that the ribbon-form rope can be used as a hoisting rope in elevators. In our view, in the elevator art, the term hoisting rope as used in Habano is synonymous with an elevator suspension rope. The appellant has not presented any evidence to the contrary.³ Second, it is our view that Habano's specific teaching that the ribbon-form rope can be used as a hoisting rope in elevators alone does provide sufficient motivation for an artisan to have replaced Gale's cables 3 with a ribbon-form rope as taught by Habano. In this regard, it must be borne in mind that where two known alternatives are interchangeable for their desired

³ Attorney argument in a brief or request for rehearing cannot take the place of evidence. See In re Pearson, id.

function, an express suggestion of the desirability of the substitution of one for the other is not needed to render such substitution obvious. See In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 568, 152 USPQ 618, 619 (CCPA 1967).

In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

REQUEST FOR REHEARING - DENIED

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OTIS ELEVATOR COMPANY
INTELLECTUAL PROPERTY DEPARTMENT
10 FARM SPRINGS
FARMINGTON, CT 06032

JVN/jg